

REMARKS

Applicants request entry of this Amendment and Response and reconsideration of the rejection of the claims.

Applicants have amended claims 1, 5, 8 and 13. The amendments to the claims are supported throughout the specification including at page 4, line 32 to page 5, line 15; page 6, lines 1-2; page 6, lines 13-22; page 7, lines 14-24; and page 13, lines 13-16. Applicants have cancelled claim 12 without prejudice or disclaimer. Applicants reserve the right to pursue the subject matter of this claim in one or more continuation applications.

Applicants request clarification regarding claims 6 and 14 as these claims are not subject to any rejection.

Rejection under 35 U.S.C. § 102(b)

The Examiner rejects claims 5-7 under 35 U.S.C. § 102(b) as allegedly anticipated by each of Ravencroft et al. (U.S. Patent No. 6,007,558; '558 patent). Applicants respectfully traverse this rejection.

Claimed subject matter is anticipated only if all of the elements of the claim are found in a single prior art reference. "Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim." *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458 (Fed. Cir. 1984); *See also*, MPEP §2131.

Claim 5 is directed to a venous filter comprising at least two struts, each having a connected and a non-connected end, wherein each of said struts comprises a strut portion, a temperature sensitive portion and an anchor portion, wherein said temperature sensitive portion is comprised of a temperature sensitive material different from the anchor portion, and wherein said material is located between said strut portion and said anchor portion and provides for separation of the anchor portion from said temperature sensitive portion upon removal of the venous filter at least in part by changing the temperature around at least said temperature sensitive portion; and a head, wherein said head connects said connected ends of said struts.

The '558 patent does not disclose all of the elements of claim 5. In the least, this patent does not disclose a strut comprising a temperature sensitive portion comprised of a temperature sensitive material different from that of the anchor portion and that provides for separation of the anchor portion from the temperature sensitive portion upon removal of the venous filter. The '558 patent discloses a device having a shaft and hook configuration that are comprised of the same material but that have a region that differs in cross sectional area to provide for removal of the hook from the vessel wall upon removal of the device.

In view of the foregoing Applicants respectfully request reconsideration and withdrawal of the rejection of claims 5-7 under 35 U.S.C. § 102(b).

The Examiner rejects claims 8, 9 and 16-19 under 35 U.S.C. § 102(b) as allegedly anticipated by O'Connell (U.S. Patent No. 6,267,776; '776 patent). Applicants respectfully traverse this rejection.

Claim 8 is directed to a venous filter comprising a web comprising a dissolvable material; and at least two anchors, wherein said at least two anchors are configured to retain said web within a mammalian blood vessel, wherein said dissolvable material comprises one piece of material that is spiraled from the outside in.

The '776 patent does not disclose all of the elements of claim 8. The '776 patent does not disclose a venous filter comprising a web of dissolvable material, wherein the dissolvable mater comprises one piece of material that is spiraled from outside in. The device of the '776 patent has a releasable retaining ring to allow conversion of the device from a basket configuration to a stent configuration. The '776 patent does not describe a device having a web comprising one piece of material.

In view of the foregoing Applicants respectfully request reconsideration and withdrawal of the rejection of claims 8,9 and 16-19 under 35 U.S.C. § 102(b).

Rejection under 35 U.S.C. § 103(a)

The Examiner rejects claims 1-5 under 35 U.S.C. § 103(a) as allegedly obvious over DeVries et al. (U.S. Patent No. 6,342,063; '063 patent). Applicants respectfully traverse this rejection.

The recent Supreme Court case, *KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1734 (2007), sets forth the legal standard for obviousness. This case reaffirms the analytical framework set out in *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1 (1966), which mandates that an objective obviousness analysis includes: (1) determining the scope and content of the prior art; (2) ascertaining the differences between the prior art and the claims at issue; and (3) resolving the level of ordinary skill in the pertinent art. *Id.* at 1734. Secondary considerations such as commercial success, long felt but unsolved needs, or failure of others may also be persuasive.

In rejecting claims under 35 U.S.C. § 103(a), the Examiner bears the initial burden of establishing a *prima facie* case of obviousness. In *re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the appellant. *Id.* at 1445. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See *Oetiker*, 977 F.2d at 1445. One criterion for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that claimed subject matter should be carried out and would have a reasonable likelihood of success viewed in light of the prior art. In *re Dow Chem. Co.*, 837 F.2d 469, 473 (Fed. Cir. 1988).

“It remains important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does”. *KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1741 (2007). “Hindsight” is inferred when the specific understanding or principal within the knowledge of one of ordinary skill in the art leading to the modification of the prior art in order to arrive at appellant’s claimed invention has not been explained. In *re Rouffet*, 149 F.3d 1350, 1358 (Fed. Cir. 1998). The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In *re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992).

Applicants’ claim 1 is directed to a venous filter comprising at least two struts each having a connected end and a non-connected end, wherein each of said struts further

comprises a strut portion and an anchor portion, wherein said anchor portion and said strut portion fit together via a positive and a negative thread, and wherein the thread on either of said strut portion, said anchor portion, or both comprises an electrolytically active thread that erodes quickly; and a head, wherein said head connects said connected ends of said struts, wherein said strut portion can be separated from said anchor portion at least in part by the application of an electrical current.

Claim 5 is directed to a venous filter comprising at least two struts, each having a connected and a non-connected end, wherein each of said struts comprises a strut portion, a temperature sensitive portion and an anchor portion, wherein said temperature sensitive portion is comprised of a temperature sensitive material different from the anchor portion, and wherein said material is located between said strut portion and said anchor portion and provides for separation of the anchor portion from said temperature sensitive portion upon removal of the venous filter at least in part by changing the temperature around at least said temperature sensitive portion; and a head, wherein said head connects said connected ends of said struts.

With regard to claim 5, the '063 patent does not teach or suggest all of the elements of the claims. In the least, the '063 patent does not teach or suggest a device with a temperature sensitive portion that provides for separation of the anchor portion from the strut upon removal of the venous filter. The device of the '063 patent describes an anchor portion that can be mechanically separated from a sleeve or separated via a sacrificial link that can be electrolytically corroded.

With regard to claim 1, the '063 patent does not disclose all of the elements of the claims. As admitted by the examiner the '063 patent does not disclose a strut comprising a strut portion and an anchor portion that fit together by a positive and a negative thread. The '063 patent also does not disclose that the thread on either the strut portion or the anchor portion or both comprises an electrolytically active thread that erodes quickly. The '063 patent describes a device having a sacrificial link that must be of a thickness to accommodate both the end of the leg and the stem of an anchor and of sufficient

thickness to attach the stem of the anchor to the leg with sufficient strength to provide for anchoring of the device during blood flow. There is no discussion in this patent of the need to provide for rapid weakening or dissolution of the connection between the strut portion and anchor portion. There is no teaching or suggestion in the patent that a thread could function to connect the leg and anchor and provide for retention of the filter during blood flow.

Based on the foregoing, Applicants request the withdrawal of the 35 USC 103 rejection on this basis.

The Examiner rejects claims 10 and 11 under 35 U.S.C. § 103(a) as allegedly obvious over O'Connell. Applicants respectfully traverse this rejection.

The '776 patent does not disclose all of the elements of claim 10 and 11. The '776 patent does not disclose a venous filter comprising a web of dissolvable material, wherein the dissolvable mater comprises one piece of material that is spiraled from outside in. The device of the '776 patent has a releasable retaining ring to allow conversion of the device from a basket configuration to a stent configuration. The '776 patent does not describe a device having a web comprising one piece of material. The ,776 patent at most shows some material between some of the legs of the filter. Since the filter of the '776 patent is designed to convert from a basket to a stent configuration, it is unlikely a dissolvable web made of a single piece of material would function to convert from the basket form to the stent form.

In view of the foregoing Applicants respectfully request reconsideration and withdrawal of the rejection of claims 10 and 11 under 35 U.S.C. § 103.

The Examiner rejects claim 15 under 35 U.S.C. § 103(a) as allegedly obvious over O'Connell in view of WasDyke (U.S. Patent No. 6,972,025). Applicants respectfully traverse this rejection.

The '776 patent does not disclose all of the elements of claim 15. The '776 patent does not disclose a venous filter comprising a web of dissolvable material, wherein the dissolvable material comprises one piece of material that is spiraled from outside in. The device of the '776 patent has a releasable retaining ring to allow conversion of the device

from a basket configuration to a stent configuration. The '776 patent does not describe a device having a web comprising one piece of material. The '776 patent at most shows some material between some of the legs of the filter. Since the filter of the '776 patent is designed to convert from a basket to a stent configuration, it is unlikely a dissolvable web made of a single piece of material would function to convert from the basket form to the stent form.

In addition, the patent discusses using different materials to provide for dissolution of the retaining ring before the legs to allow conversion to a stent form. However, there is no discussion of dissolution based on thickness of the web material.

The deficiencies of the '776 patent are not remedied by reference to the Wasdyke patent. This patent describes a device with biodegradable centering piece. The piece is designed to center the venous filter. The patent does not describe a filter comprising a web comprising one piece of material. In addition, although dissolution of the biodegradable centering piece is discussed, thickness as a criteria affecting dissolution is not mentioned. Since a web does not form part of the centering piece of the Wasdyke patent, one of skill in the art would not consider thickness of the web material as a criterion for dissolution.

In view of the foregoing Applicants respectfully request reconsideration and withdrawal of the rejection of claim 15 under 35 U.S.C. § 103.

The Examiner rejects claims 12 and 13 under 35 U.S.C. § 103(a) as allegedly obvious over O'Connell in view of Yadav et al. (U.S. Patent No. 6,391,044). Claim 12 has been cancelled, rendering the rejection of this claim moot. Applicants respectfully traverse this rejection.

The '776 patent does not disclose all of the elements of claim 13. The '776 patent does not disclose a venous filter comprising a web of dissolvable material, wherein the dissolvable material comprises one piece of material that is spiraled from outside in. The device of the '776 patent has a releasable retaining ring to allow conversion of the device from a basket configuration to a stent configuration. The '776 patent does not describe a device having a web comprising one piece of material. The '776 patent at most shows some material between some of the legs of the filter. Since the filter of the '776 patent is

designed to convert from a basket to a stent configuration, it is unlikely a dissolvable web made of a single piece of material would function to convert from the basket form to the stent form.

In addition, the patent does not discuss other pieces of dissolvable material that crosslinks the spiraled piece of dissolvable material. Since the purpose of the design in the '776 is to allow conversion to a stent form, it is unlikely that a web comprised of one piece of material that is cross linked would function as the device converts from basket to a stent configuration.

The deficiencies of the '776 patent are not remedied by reference to the Yadav patent. This patent describes a device that is removable and does not disclose a dissolvable web. The spiral configuration in the Yadav patent provides for the ability to wind the membrane around the guidewire for removal. There is no discussion of crosslinking the web material or of dissolvable web material as the device is designed to be removed.

In view of the foregoing Applicants respectfully request reconsideration and withdrawal of the rejection of claim 13 under 35 U.S.C. § 103.

SUMMARY

Applicants submit the claims are now in condition for allowance. Applicants request notification to that effect. The Examiner is invited to contact Applicants' representative if prosecution maybe assisted.

Respectfully submitted,

MERCHANT & GOULD P.C.
P.O. Box 2903
Minneapolis, Minnesota 55402-0903
(612) 332-5300

Date:

January 7, 2009

Katherine M. Kowalchuk
Katherine M. Kowalchuk
Reg. No. 36,848

45074

PATENT TRADEMARK OFFICE